

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1638  
#9  
GundtB

<b>Re:</b>	Patent Application for Stelpflug	<b>Dated:</b>	April 2, 2003
<b>Serial</b>	09/811,051	<b>Art Unit:</b>	1638
<b>No.:</b>			
<b>Filed:</b>	March 15, 2001	<b>Examiner:</b>	Medina Ibrahim
<b>For:</b>	Inbred Corn Line G2801	<b>Action:</b>	Amendment

**To:** The Commissioner of Patents and Trademarks, Washington, DC 20231

This is a response to the office action dated 01/02/03, which was nonfinal. No extensions of time are thought to be required. If one is required it is hereby requested and the cost should be withdrawn from Acct. 07-0190.

**35 USC §112, second paragraph**

1.

The Examiner rejected claims 4-5 and 8-19 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This was because some claims recited corn and others maize. The claims have been amended to consistently recite corn. The Examiner is asked to please remove this rejection.

Claim 4 has been altered according to the Examiner's suggestion although the applicant does not concur with the Examiner. The cells or protoplasts were used in an appropriate manner, but since the claim is not altered by the Examiner's suggested language, this language was employed.

The Examiner's suggestion to amend claim 5 from "capable of expressing" to "having" is not followed. Firstly, capable of expressing requires that the plant must be capable at some point. The Examiner says that there is an implication that the plant may or may not express. The reality of corn plants is that they grow from a little seed into a mature plant and then into a senscensing plant. In these various stages the plant may not have all of the physiological and morphological characteristics however it is "Capable of expressing" such characteristics. The word "having" does not address the issue of a plant that will be changing throughout a season of growing.

Concerning claims 15 and 16 the Examiner is saying the claim is indefinite. And the Applicants arguments are not persuasive and misdirected to written description. However, the federal circuit defines indefiniteness in light of the ordinary skilled person in the art. The judge held that, § 112 2<sup>nd</sup> , requires that the specification and claims must particularly point out and distinctly claims subject matter, which the applicant regards as his invention. This is met until, 'one skilled in the art would understand the bounds of the claim when read in light of the specification,' Exxon Research and Engineering Co. U.S.265 F. 3d. 1371, 60 USPQ2d 2n (Fed Cir Sept 19<sup>th</sup> 2991). Thus what one skilled in the art would know i.e. the prior art is a valid argument. One skilled in the art would understand what a mutant gene was and how to introduce it into the plant. Especially since this breeding art has been in practice for years.

Claim 19 has been amended to say biotechnology techniques and genotyping. See pages 18, 19 ( isozyme data) pages 3 , 4 of the specification( other markers). This type of genotyping allows the inbred to be identified as the same as the present invention.

### **35 USC §112, first paragraph deposit requirement**

Since the Examiner notes that deposit of the seed will overcome the rejection and we have indicated that if claims are found allowable that the material will be deposited. We ask that the Examiner hold on this rejection in abeyance.

### **35 USC §112, first paragraph.**

Claims 12-19 are rejected under §112. The Examiner is indicating that the subject matter is not described. However, "The law is clear that patent documents need not include subject matter which is known in the field of the invention." See S3 Inc. V. nVIDIA Judge Newman's dissent. Atmel Corp. V Information Storage Devices, Inc., 198 F.3d 1374,1382, 53 USPQ2d 1225 (Fed. Cir. 1999) holds an accommodation to the 'common experience' of lay persons maybe feasible", such is an unnecessary burden placed on the inventors.

The purpose of the enablement requirement is to ensure that the inventor has provided sufficient information about the claimed invention, to allow a person of ordinary skill in the art, relying on the

specification and the are to make and use the invention without undue experimentation. That some experimentation is required is not fatal on if it is undue experimentation Cf. *Molecoln Research Corp. v. CBS, Inc.* 793 F2d 1261 (Fed. Cir. 1986). In *Adang v. Fischhoff*, 286 F3d 1346 (Fed Cir. April 10 2002). The court looked at the Art to see if it was "substantially unpredictable" as of the filing date of Adang Application. Please note that the filing date of this application is the early 2000's. That is eleven years or so after the art cited by the Examiner. The Examiners cited art is from the dinosaur age and the art is no longer substantially unpredictable. At the time of the Adang disclosure art the art of transforming may have been substantially unpredictable. Clearly that is not and has not been true for 30 years concerning mutant line. Nor has it been true for the last 8 years in corn transformation. If the Examiner persists in this rejection the applicant will provide documentation of the predictability of the art.

The Examiner indicates that there may be disequilibrium, linkage drag or epistatic effects. The Federal court has addressed this issue. The court indicated that some experimentation is required is not fatal on if it is undue experimentation Cf. *Molecoln Research Corp. v. CBS, Inc.* 793 F2d 1261 (Fed. Cir. 1986). In *Adang v. Fischhoff*, 286 F3d 1346 (Fed Cir. April 10 2002). The Examiner citing a 1990 article states that a transformation process did not result in the expected results. This article was written in the infancy of the transformation process. The transformation process is now in a fully formed and routinely practiced art.

The Examiner is aware as should be anyone familiar with corn that in the late 1980's corn transformation was developed. In the pass 13 or so years until the filing of this application 100s if not 1000s of applications on transformation have been filed. The art of transforming is now routine and does not carry any undue burden or undue experimentation. The applicant's attorney is confused as to why the Examiner is trying to ignore the skill of the ordinary man in this art and pretend that the last 12 or 13 years of scientific research and development in biotechnology doe not exist.

#### Written Description

The Examiner rejected claims 6-17 as containing subject matter, which was not, described in the specification in a way as to show that the applicant had possession of the invention. The applicant followed the guidelines, which say state that:

"... The written description requirement, a question of fact, ensures that the inventor conveys to others that he or she had possession of the claimed invention; whereas, the enablement requirement, a question of law, ensures that the inventor conveys to others how to make and use the claimed invention."... " to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Possession may be shown in a variety of ways including description of an actual reduction to practice"

And then pointed out that the application showed that millions of corn fitting the claims was in the applicants possession. The Examiner has come back and said that the genotype and characteristics for these millions of seed was not shown and thus there is no compliance the written description requirement. However according to the guidelines, which the Federal Circuit has adopted, the written description requirement is a question of fact. It ensures that the inventor conveys to others that he or she had possession of the claimed invention. The Examiner and the patent office have to follow these guidelines and remove the rejection.

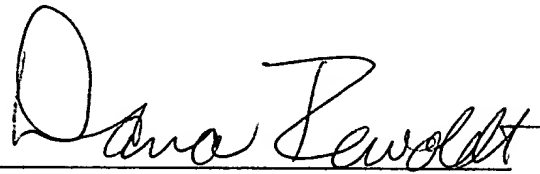
The office needs to focus on who is the ordinarily skilled person. Would that person in light of the specification and the knowledge at the filing date understand that the applicant had the claimed invention. Yes he would. The ordinarily skilled person knows the family tree of numerous lines of corn. This is a means by which the industry looks at and identifies germplasm. Just because the traits the patent office wants to see are not listed does not mean or imply that the written description is not adequate.

The Examiner and the Office should clearly look at what the Examiner states on page 14. The Examiner states that they cannot determine whether the prior art plant possesses the unrecited features. The Examiner does not have sufficient facts to determine if plant and seeds are the same. In addition, The Examiner cannot conclude whether the claimed subject matter would have been obvious since it cannot determine whether the corn plants differ. The applicant has given the

answer. If the material does not have this new plant as an ancestor then it is not claimed. The Examiner has shown no evidence that these claims require or have used the deposited material as an ancestor. Thus it is requested that this rejection <sup>e</sup>by removed.

Thus the Examiner is respectfully requested to reconsider this rejection and if deemed appropriate to please remove this rejection to the listed claims under 102/103.

Respectfully submitted,

A handwritten signature in cursive script, reading "Dana Rewoldt", is written over a horizontal line.

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